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(H)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/037,657 03/10/98 WILLSON

T 10857Z

EXAMINER
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SCULLY SCOTT MURPHY & PRESSER  
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GARDEN CITY NY 11530

HAMILTON	
ART UNIT	PAPER NUMBER

1646  
DATE MAILED:

05/17/99

**Please find below and/or attached an Office communication concerning this application or  
proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/037,657**

Applicant(s)  
**WILLSON et al.**

Examiner  
**Fozia Hamud**

Group Art Unit  
**1646**



☒ Responsive to communication(s) filed on Jun 12, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-34 ~~is~~ are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-34 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

x Notice to comply with sequence Rules

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Group I. Claims 1-19, drawn to an isolated nucleic acid encoding a haemopoietin receptor, classified in class 536, subclass 23.5.
- Group II. Claims 20-27 and 30, drawn to an isolated haemopoietin receptor, classified in class 530, sub class 351.
- Group III. Claims 28-29, drawn to a method for modulating expression of NR6 in a mammal using a DNA encoding NR6, classified in class 514, sub class 44.
- Group IV. Claim 31, drawn to an antibody which specifically binds with a haemopoietin receptor, classified in class 530, sub class 387.1.
- Group V. Claims 32-34, drawn to a transgenic animal comprising a mutation in at least one allele of the gene encoding NR6, classified in class 800, sub class 21.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, IV - V are independent and distinct, each from the other, because they are products which possess characteristic differences in structure and function and each has an independent utility, that is distinct for each invention which cannot be exchanged. The nucleic acid of Group I can be used to make a hybridization probe or can be used in gene therapy as well as in the production of the haemopoietin receptor. The protein of Group II can be used other than to make the antibody of Group IV, such as it can be used as a probe, or used therapeutically or diagnostically (e.g. in screening). Although the antibody of Group IV can be used to obtain the nucleic acid of Group

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I, it can also be used in diagnostics (e.g. as a probe in immunoassay, or in immunochromatography) or it may be used therapeutically. The transgenic animal of Group V can be used to produce large quantities of the protein of interest, however, it is structurally and functionally different from the products of Groups I-II, IV. A search from any of the above Groups would not necessarily reveal art to any other Group.

Inventions I and III are related as a product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the nucleic acid of Group I as claimed can also be used as a hybridization probe or in the recombinant production of the encoded protein.

Inventions II-III and IV-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the haemopoietin receptor of Group II, the antibody of Group IV or the transgenic animal of Group V are neither used nor produced in the method of Group III.

2. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

3. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

Applicant is given ONE MONTH, or THIRTY DAYS, whichever is longer, from the mailing date of this letter within which to comply with the sequence rules, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). In no case may an applicant extend the period for reply beyond the SIX MONTH statutory period. Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fozia Hamud whose telephone number is (703) 308-8896. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310.

Official papers filed by fax should be directed to (703) 308-4227. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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FH  
Fozia Hamud  
Patent Examiner  
Art Unit 1646  
May 14, 1999

*Prema Mertz*  
PREMA MERTZ  
PRIMARY EXAMINER

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING  
NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 CFR 1.821.825. Applicant's attention is directed to these regulations, published at 11429, May 15, 1990 and at 55 FR 18230, May 1, 1990.
- ☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 CFR 1.821(c).
- ☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 CFR 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 CFR 1.822 and/or 1.823, as indicated on the attached copy of marked-up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).
- ☐ 7. Other: \_\_\_\_\_

## Applicant must provide:

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing"
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d)

For questions regarding compliance with these requirements, please contact

For Rules Interpretation, call (703) 308-1123

For CRF submission help, call (703) 308-4212

For PatentIn software help, call (703) 557-0400

Please return a copy of this notice with your response.